UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,630	02/10/2004	Masami Mizutani	1075.1246	9459

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER
HILLERY, NATHAN

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/774,630	MIZUTANI ET AL.
	Examiner	Art Unit	
	Nathan Hillery	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 September 2007*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

    4a) Of the above claim(s) <u>17</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 8-16* is/are rejected.

7)☒ Claim(s) *5-7* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: Amendment filed on 9/11/07.

2.   Claims 1 – 17 are pending in the case. Claims 1, 8, 12 and 16 are independent

with claims 1 – 16 having been elected at this time.

Election/Restrictions

3.   Claim 17 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as

being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on 3/20/07.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

5.   Claim 16 is rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

6.   Claim 16 is considered software per se. Computer programs may be explicitly

claimed as, for example, a series of code or instructions for performing functions or may

be implicitly claimed as, for example, a system, a module or an apparatus, the latter

being the case here in the form of a system that does not necessarily require hardware.

Thus a claim to functional descriptive material, including computer programs, per se, is

not patent eligible subject matter. It should be noted that functional descriptive material

claimed in combination with an appropriate computer storage medium to enable the

functionality to be realized is patent eligible subject matter if it is capable of producing a

useful, concrete and tangible result when used in the computer system.

7.   Further, to expedite a complete examination of the instant application, the claims

rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth

below in anticipation of applicant amending these claims to make them statutory.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9.   Claims 1 – 4 and 8 – 16 are rejected under 35 U.S.C. 102(b) as being clearly

anticipated by Nielsen (Designing Web Usability).

10.   **Regarding independent claim 1**, Nielsen teaches that spoken words are

sometimes harder to understand, especially if the speaker is sloppy, has a dialect,

speaks over a distracting soundtrack, or simply speaks too quickly. The classic solution

to these problems is to use subtitles (p 1, fourth full paragraph), which meet the

limitation of **a text display time calculation processing unit for calculating a display

time period of text media to be included in said output multimedia contents, on

the basis of conversion instruction information**;

        Nielsen teaches that traditional subtitles look good on a full-sized videotape.

Unfortunately, the subtitles are virtually unreadable when the video is reduced to the

size usually transmitted over the Internet (left image). Much better readability is gained

from placing the subtitles in a letterbox and sizing them for computer viewing (right

image) (p 2, second full paragraph), which meet the limitation of **a spatiotemporal**

layout information setting processing unit for setting spatiotemporal layout information on said output multimedia contents on the basis of said conversion instruction information; and

Nielsen teaches that to preserve the feeling of user control, even when presenting multimedia, try segmenting longer presentations into short chapters that can be chosen from a menu. When converting a television news program to the Web, for example, break the program into one segment for each news story (p 2, third full paragraph), which meet the limitation of **a contents conversion processing unit for converting said input multimedia contents into said output multimedia contents on the basis of said spatiotemporal layout information,**

Nielsen teaches that we can save download time by transmitting the subtitles as ASCII (or Unicode) and have them rendered in the letterbox on the client machine: a perfect job for an applet. It should also be possible to have the user select the language for the subtitles through a preference setting or a pop-up menu (p 2, last paragraph), which meet the limitation of **said spatiotemporal layout information setting processing unit setting a display time period of said text media included in said spatiotemporal layout information, on the basis of said display time period of said text media calculated in said text display time calculation processing unit, and setting a playing time period of said media other than said text media included in said spatiotemporal layout information, on the basis of said display time period of said text media set as said spatiotemporal layout information.**

11.   **Regarding dependent claim 2**, Nielsen teaches that traditional subtitles look

good on a full-sized videotape. Unfortunately, the subtitles are virtually unreadable

when the video is reduced to the size usually transmitted over the Internet (left image).

Much better readability is gained from placing the subtitles in a letterbox and sizing

them for computer viewing (right image). Doing so does not increase the file size

proportionally because the black area compresses very nicely (p 2, second full

paragraph), which meet the limitation of **said text display time calculation**

processing unit calculates said display time period of said text media to be

included in said output multimedia contents, on the basis of text information

obtained from said input multimedia contents and text display from information

inputted as said conversion instruction information.

12.   **Regarding dependent claim 3**, Nielsen teaches that to preserve the feeling of

user control, even when presenting multimedia, try segmenting longer presentations

into short chapters that can be chosen from a menu. When converting a television news

program to the Web, for example, break the program into one segment for each news

story. Then, prepare a standard web page that lists the stories with a short summary

and a single thumbnail photo from the most visual ones. Allow users to link to individual

stories from this page (p 2, third full paragraph), which meet the limitation of **said**

spatiotemporal layout information setting processing unit sets a playing time

period of said media other than said text media included in said spatiotemporal

layout information to coincide with said display time period of said text media set

as said spatiotemporal layout information.

13.   **Regarding claims 8 – 10, 12 – 14 and 16**, the claims incorporate substantially

similar subject matter as claims 1 – 3 and are rejected along the same rationale.

Claim Rejections - 35 USC § 103

14.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action: ·

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15.   Claims 4, 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Nielsen (Designing Web Usability) as applied to claims 1, 8 and 12 above, and

further in view of Oliver et al. (Sams Teach Yourself HTML and XHTML).

16.   **Regarding dependent claim 4**, Nielsen teaches that to preserve the feeling of

user control, even when presenting multimedia, try segmenting longer presentations

into short chapters that can be chosen from a menu. When converting a television news

program to the Web, for example, break the program into one segment for each news

story (p 2, third full paragraph), which meet the limitation of **a segment playing time**

setting unit for setting a playing time period of each of segments of said media

other than said text media to be included in said output multimedia contents;

Nielsen teaches that then, prepare a standard web page that lists the stories with a short summary and a single thumbnail photo from the most visual ones. Allow users to link to individual stories from this page (p 2, third full paragraph), which meet the limitation of **a total playing time calculation unit for calculating a total playing time period of all said segments of said media other than said text media on the basis of said playing time period of each of said segments of said media other than said text media set in said segment playing time setting unit;**

Nielsen does not explicitly teach **a repeat count setting processing unit for setting a repeat count of said media other than said text media on the basis of said display time period of said text media calculated in said text display time calculation processing unit and said total playing time period of all said segments of said media other than said text media,** nor **said contents conversion processing unit making a conversion of said media other than said text media included in said input multimedia contents on the basis of said repeat count set in said repeat count setting processing unit.**

Oliver et al. teach that The HTML page in Figure16.3 demonstrates the use of <embed /> with a video clip in the Windows AVI (Audio-Video Interleave) format. The <embed /> tag in Figure 16.3 also includes the autostart and loop attributes, which tell Netscape's LiveVideo plug-in to start playing the video when the page loads and to repeat it as long as the page is being displayed (p 1, first paragraph), which meet the limitation of **a repeat count setting processing unit for setting a repeat count of said media other than said text media on the basis of said display time period of**

said text media calculated in said text display time calculation processing unit

and said total playing time period of all said segments of said media other than

said text media,

Oliver et al. teach that the <embed /> tag in Figure 16.3 also includes the ·

autostart and loop attributes, which tell Netscape's LiveVideo plug-in to start playing the

video when the page loads and to repeat it as long as the page is being displayed.

Figure 16.4 shows the resulting page as viewed with Netscape 4 (p 1, first paragraph),

which meet the limitation of **said contents conversion processing unit making a**

conversion of said media other than said text media included in said input

multimedia contents on the basis of said repeat count set in said repeat count

setting processing unit.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to combine the invention of Nielsen with that of Oliver et al. because such a

combination would provide the users of Nielsen with the benefit of an advanced method

of Embedding Video in a Web Page (pp 1 and 2).

17.   **Regarding claims 11 and 15,** the claims incorporate substantially similar subject

matter as claim 4 and are rejected along the same rationale.

Response to Arguments

18.   Applicant's arguments filed 9/11/07 have been fully considered but they are not

persuasive.

19.   In response to applicant's arguments, the recitation "to convert input multimedia

contents oriented to a personal computer to be displayed on a screen with a

predetermined size, including text media and media other than the text media, into

output multimedia contents oriented to a portable terminal to be displayed on a screen

with a size smaller than said predetermined size" (pp 9 - 10) has not been given

patentable weight because the recitation occurs in the preamble.

20.   A preamble is generally not accorded any patentable weight where it merely

recites the purpose of a process or the intended use of a structure, and where the body

of the claim does not depend on the preamble for completeness but, instead, the

process steps or structural limitations are able to stand alone. See *In re Hirao*, 535

F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88

USPQ 478, 481 (CCPA 1951).

Allowable Subject Matter

21.   Claims 5 – 7 are objected to as being dependent upon a rejected base claim, but

would be allowable if rewritten in independent form including all of the limitations of the

base claim and any intervening claims.

Conclusion

22.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Nathan Hillery whose telephone number is (571) 272-

4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Doug Hutton can be reached on (571) 272-4137. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NH

/Doug Hutton/
Doug Hutton
Supervisory Primary Examiner
Technology Center 2100